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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/964,538 | 09/28/2001 | Ju Hyun Lee | MRE-0010A | 2653 |
| 34610 | 7590 | 05/10/2004 | | EXAMINER |
| FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153 | | | | LUU, THANH X |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2878 | |

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------|---------------------|-----|
| Office Action Summary | Applicant No. | Applicant(s) | |
| | 09/964,538 | LEE ET AL. | |
| | Examiner | Art Unit | PRW |
| | Thanh X Luu | 2878 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i o rity for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 November 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Pri ority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to remarks filed April 27, 2004. Claims 1-43 are currently pending.

Examiner notes that in the last office action, the Office Action Summary stated that the action was non-final, but in the conclusion of the office action, Examiner stated that the action was final. To correct for the inconsistency, the finality of the previous office action is withdrawn and this present office action is made final.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the light sensing element comprising a camera and a scanner must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It appears that Applicant has failed to disclose an embodiment in which there is a transparent electrode layer without the need for an additional electrode overlaying the luminescence layer. In response, Examiner invites Applicant to cite portions of the specification that supports such language. Examiner also reminds Applicant that no new matter may be added.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hallibert et al. (U.S. Patent 6,002,786).

Regarding claims 41-43, Hallibert et al. disclose (see Figure 1) a contact imaging system, comprising: a light sensing element (26); a transparent insulating layer (10) overlaying the light sensing element; a transparent electrode layer (12) overlaying the transparent insulating layer; a luminescence layer (14) overlaying the electrode layer; and a stray light shield layer or protective layer (32 or unlabeled layer directly underneath finger) overlaying the luminescence layer, wherein the luminescence layer and the electrode layer are configured such that an electric field can be applied between an object to be imaged and the electrode layer. Hallibert et al. also disclose (see Figure

1) a penetrating control layer (30) overlaying the luminescence layer configured to limit an amount of a substance which may pass through.

Response to Arguments

6. Applicant's arguments with respect to claims 1-43 have been considered but are not persuasive.

Applicant asserts that the figures show a scanner and a camera. Examiner disagrees. Figure 10 simply shows the semiconductor structure of a photodetector. Nowhere does it show the scanning nature of the device or the optical system that is necessary for the device to be a camera.

Applicant also asserts that there is proper support for the language "without the need for an additional electrode overlaying the luminescence layer" in the figures. Examiner disagrees. In order to provide proper support for a negative limitation, Applicant must have affirmatively stated in the original disclosure the absence of such a feature. Absence of such a feature from the figures is not sufficient to provide support. On the contrary, it appears that Applicant has added such language in response to the prior art cited by the Examiner. That is, Applicant did not think of absence of such a feature as part of the invention in the original disclosure. Examiner reminds Applicant that the invention should be claimed in a positive manner and not with negative limitations.

Lastly, Applicant asserts that the layer of the prior art does not "limit an amount of a substance which may pass through." Examiner disagrees. A substance can be any substance. Since a layer physically exists, the layer is configured to limit an amount of

a substance (e.g. dust or dirt) which may pass through.

Thus, as set forth above, this rejection is proper.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

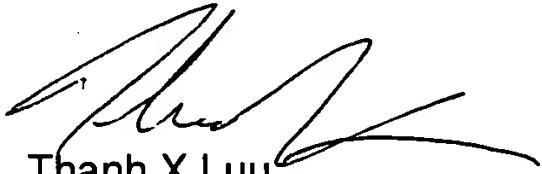
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878

05/04